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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,303	03/31/2000	Atul Suklikar	SIEB042/00US	1042
25096	7590	11/01/2005	EXAMINER	
PERKINS COIE LLP			QUELER, ADAM M	
PATENT-SEA			ART UNIT	
P.O. BOX 1247			PAPER NUMBER	
SEATTLE, WA 98111-1247			2178	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/540,303

Applicant(s)

SUKLIAR ET AL.

Examiner

Adam M. Queler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8 and 15-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 8 and 15-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to communications: Amendment filed 08/04/2005.
2. Claims 8 and 15-31 are pending in the case. Claims 8 and 23 are independent claims.
3. The objection to the Drawings is withdrawn in view of the Replacement Drawings.

#### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 8 and 15-31 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

The specification appears to be written for one who has a working knowledge of Siebel's web engine, as there are several terms that are not defined or used differently than their commonly accepted meaning. Applicant alleges that the Siebel system is only provided as an example but numerous portions of the specification rely on knowledge of it for explanation. As such, one of ordinary skill in the art would have to resort to undue experimentation to understand the invention, much less make and/or use the invention.

For example, it is not clear what a display object is. In the specification (p. 6) an object is defined as "a repository representation of an HTF." "HTF" is never similarly defined.

Applicant claims the HTF is not necessary for the understanding of "display objects" but uses it

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in the explicit definition of the term found on page 6. That this is in the Definitions section of the specification is particularly troublesome. The claim language and the specification are replete with similar ambiguities. Objects are defined in terms of other objects and an actual example is never shown. "Applet" while no longer used in the claims, also seems to be used in different manner than its common meaning. Applets are defined as having controls and fields, also with no meaning attached to them. Claim 8 recites "objects containing information about tags that provide directives for creating the web page." It is unclear whether the "information" or the "tags" contain the "directives." It is similarly unclear as to what the information entails. Business object model is also not adequately defined. It is unclear how a business object model can be comprised of web pages, and then be transformed into web pages as the "page delivery language" application.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 8 and 15-31 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

As described above, the lack of enablement, and ambiguity in the claims renders the scope of the claims indefinite. For examining purposes only the claims will be rejected using what is determined to be the closest art available, until the metes and bounds of the claims are more fully determined.

The term "according to the style" in claims 19 and 28 is a relative term that renders the claim indefinite. The term "according to the style" is not defined by the claim, the specification

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does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 8, 15-17, 21-26 and 30-31 rejected under 35 U.S.C. 102(e) as being anticipated by Simonoff et al. (US006005568A, filed 12/21/1999).**

**Regarding independent claim(s) 8 and 23**, Simonoff teaches an object model for performing a task (col. 3, ll. 44-59). Simonoff teaches a display objects based on the models (col. 5, ll. 43-53). Simonoff teaches templates for controlling the presentation, including a placeholder (applet tag) for binding the object (col. 5, ll. 54-67). Simonoff teaches assembling them into a page delivery language thin client application (col. 8, ll. 49-50).

**Regarding dependent claim(s) 15-17 and 24-26**, as the intended use of the claims would not result in a manipulative difference the prior art and the claimed invention(s); the claims are similarly rejected as claims 8 and 13 above. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963) and *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962).

**Regarding dependent claim(s) 21 and 30**, Simonoff discloses HTML (col. 5, ll. 54-67).

**Regarding dependent claim(s) 22 and 31**, Simonoff teaches applets and HTML files (col. 5, ll. 54-67). These are inherently stored separate from each other.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**11. Claims 20 and 29 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Simonoff.**

**Regarding dependent claim(s) 20 and 29,** Simonoff does not explicitly disclose editing HTML with an HTML development tool. It would have been obvious to one of ordinary skill in the art at the time of the invention to use an HTML development tool, because the templates were HTML files (col. 5, ll. 54-67).

**12. Claims 18, 19, 27, and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over Simonoff, and further in view of Lipkin (US 20020049788A1, provisional date 1/14/2000).**

**Regarding dependent claim(s) 18 and 27,** Simonoff does not explicitly disclose maintaining style with CSS. Lipkin teaches maintaining style with CSS (para. 750). It would have been obvious to one of ordinary skill in the art at the time of the invention to use CSS, as it would enable the pages to have a specific look-and-feel (para. 750).

**Regarding dependent claim(s) 19 and 28,** Simonoff does not explicitly disclose maintaining consistency. Lipkin teaches maintaining consistency with CSS (para. 750). It would have been obvious to one of ordinary skill in the art at the time of the invention to use CSS, as it would enable the pages to have a specific look-and-feel (para. 750).

***Response to Arguments***

Applicant's arguments filed 08/04/2005 have been fully considered but they are not persuasive.

**Regarding Applicant's remarks on pp.7-8, regarding enablement:**

Applicant alleges that the terms are described throughout the specification and gives paragraph numbers as citations. The Office has no record of marked paragraph numbers, and Applicant is advised to use the page and line numbers in the Application as originally filed, which can be seen via the PAIR system. Nevertheless, a more accurate description would be that the terms are used throughout the specification, not described. Applicant alleges that the Siebel system is only provided as an example but numerous portion of the specification rely on knowledge of it for explanation. Similarly, Applicant claims the HTF is not necessary for the understanding of "display objects" but uses it the definition of the term found on page 6.

The minimal burden for an enablement rejection is for the examiner to give reasons for the uncertainty of the enablement. This was done previously and in the instant action as well. Applicant's arguments merely allege enablement. Once the examiner has established a prima facie case of lack of enablement, the burden falls on the applicant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would have been able to make and use the claimed invention using the disclosure as a guide. See *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973). The arguments of counsel cannot take the place of evidence in the record. See *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

**Regarding Applicant's remarks on Claims 8, and 15-31:**

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As scope of the claims is indefinite due to the enablement issues noted above, it is impossible to determine whether or not the claims overcome the prior art until the claims proper meaning can be determined.

*Conclusion*

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

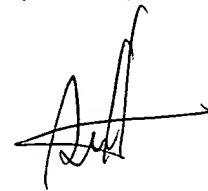
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**